

IN THE UNITED STATES PATENT OFFICE

In re Application of
Hideaki Takahashi

App. No.: 10/707589
Filed: December 23, 2003
Conf. No.: 1588
Title: ROTARY ELECTRIC DEVICE
Examiner: Y. Comas
Art Unit: 2834
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SECOND FOLLOW UP ON UNANSWERED REQUEST FILED SEPTEMBER 10, 2006.

Dear Sir:

PROSECUTION HISTORY

Applicant's attorney will restate the condition of this case and its prosecution history in order to present applicants position in this paper. Also this is being done for a review by the Commissioner's Office.

A final rejection was issued in this case on January 25, 2006, which was based in part on a newly cited reference Daikou 6,737,778. Immediately thereafter on January 26, 2006 applicant filed a petition to the Commissioner requesting him to exercise his supervisory authority and direct the Examiner to withdraw the finality of the Office Action, dated January 26, 2006, based on the newly cited reference. In making the rejection final based on this newly cited reference the Examiner took the position that the citation of a new reference was necessitated by applicant's amendment that allegedly raised a new issue, but cites no wording added that supports this allegation.

This alleged new issue was an amendment to claim 1 to included a feature clearly disclosed and thus did not raise a "new issue". In this regard, the MPEP Section 904.03 states "It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment."

Further more the position is particularly egregious inasmuch as the amendment made to claim 1 incorporated the subject matter previously claimed in claim 4 which was canceled. The Examiner's attention was clearly stated in the Remarks Section where it was stated "claim 1 has been amended to incorporate the features of original claim 4".

In spite of the immediate filing of this petition one day after the complained about action of the Examiner, no response was made in a timely manner. Thus the undersigned was forced to send a follow up letter nearly three months later, on April 23, 2006 pointing out, among other things that applicant should not have to pay extension fees for the Office's delays.

The shortened time for response passed and still no reply was forthcoming. Then, after the case became technically abandoned on August 1, 2006 applicant's petition was granted with the statement "prosecution on the merits of the instant application is not closed, and any response to the 1/25/06 office action will be considered as a response to a non-final action. " (emphasis added)

It is thus fair to take the position that this decision on August 1, 2006 in effect reopened prosecution and set a new period for response due to the Office's delay.

Immediately thereafter on August 6, 2006 a response was filed and in doing so the undersigned volunteered that technically the period for response had passed and thus filed, in addition, a petition requesting that the response be considered timely filed. That petition was denied in a paper date stamped September 2, 2006, but which the Pare records show as being actually mailed September 5, 2006. That later date seems to be correct as the 2nd was a Saturday before Labor Day and the 5th is the first work day after the three day week end.

Thus it is believed that fairness dictates that the decision dated August 1, 2006 be considered a reopening of prosecution and that the response of August 6 2006, was in fact timely. The facts stated above further prove that any delayed prosecution was caused on the USPTO side and not by applicant

Respectfully submitted:


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